



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/280,699	03/30/1999	TAKAHIRO MATSUMURA	990377	6201

23850 7590 11/20/2003

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

CRAVER, CHARLES R

ART UNIT PAPER NUMBER

2682

DATE MAILED: 11/20/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/280,699

Applicant(s)

Matsumura

Examiner

Charles Craver

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7, 10, and 16-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 10, and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 21 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 10, 16, 17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ushiki et al, JPO Laid-Open Application 9-259391.

Claims 1, 4, 10, 20 and 21: Ushiki discloses a telephone set identifying method and apparatus for utilizing a first section for identifying a type of portable telephone set to which a data processing apparatus (1) is coupled via a port (FIG 1), comprising the steps of identifying the type of device attached in response to a received signal from the first section received at a data interface part of the mobile device (PARA 0026). Ushiki further discloses that the signal sent is of the communication protocol (reads operation start signal), and information is set indicating the protocol corresponding to the type of telephone set (PARA 0026). **Further regarding claim 10:** Ushiki discloses that the method is performed by a CPU, which inherently utilizes a computer-readable storage medium to perform the process using a computer. **Claims 16, 17 and 19:** Ushiki discloses that the type includes a connection system used by the set.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushiki et al.

Claim 7: Ushiki discloses a telephone set identifying method and apparatus for utilizing a first section for identifying a type of portable telephone set to which a data processing apparatus (1) is coupled via a port (FIG 1), comprising the steps of identifying the type of device attached in response to a received signal from the first section received at a data interface part of the mobile device (PARA 0026). Ushiki further discloses that the signal sent is of the communication protocol (reads operation start signal), and information is set indicating the protocol corresponding to the type of telephone set (PARA 0026), and that the method is performed by a CPU, which inherently utilizes a computer-readable storage medium to perform the process using a computer.

Ushiki fails to disclose that the CPU is a part of a PC card, however, such an interface was notoriously well-known at the time of the invention, and as such the examiner takes Official Notice of such a feature, asserting that it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to Ushiki so as to use a standardized package

for the connector and connection means, reducing manufacturing costs.

Claim 18: Ushiki discloses that the type includes a connection system used by the set.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4, 7, 10 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7 and 10 of copending Application No. 09/957,081 in view of Ushiki.

09/957,081 discloses the applicant's invention of claims 1, 4, 7, 10 and 20, but fails to disclose that the type is identified by the communication protocol. Ushiki discloses the utility of using a communication protocol to identify a type of telephone set. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to 09/957,081 in order to ease identification.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

3. Applicant's arguments filed 8-28-03 have been considered but are moot in view of the new grounds of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is 703-305-3965. The examiner can normally be reached on Monday thru Friday: 9-18:30, off 1st Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached on 703-308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6306 for regular communications and 703-308-6296 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should

Application/Control Number: 09/280,699

Page 6

Art Unit: 2682

be directed to the receptionist whose telephone number is 703-305-4700.

Charles Craver

cc

November 17, 2003


CHARLES CRAVER
PATENT EXAMINER